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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,120	12/21/2000	Chikara Uratani	36856.422	9930

7590

11/29/2002

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EXAMINER

GILMAN, ALEXANDER

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,120

Applicant(s)

URATANI ET AL.

Examiner

Alexander Gilman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2002 and 10 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claim 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuriyama et al.

With regard to claims 1-3, 11, and 14, Kuriyama et al (US Pat. No. 6,068,499) disclose an electronic component comprising:

an insulative case (2) made of resin;

a plurality of surface-mounting terminals (12, 11) mounted on said insulative case;

at least one notch provided in said insulative case to accommodate a lead portion of at least one of surface-mounting terminals; and

said notch defining a clearance (Fig. 2,) between the solder fillet portion of (11, 12) and lower-side insulative case (2b).

Kuriyama et al do not disclose that the notch is extending entirely through the insulative case.

To extend the notch entirely through the insulative case would have been an obvious matter of design lacking criticality, since the function performed by the notch is the same.

The above mentioned limitation is not patentably significant since they relate to the size of the article under consideration which is not ordinarily a matter of invention. In re Yount, 36 C.C.P.A. (Patents) 775, 171 F.2d 317, 80 USPQ 141.

It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

With regard to claims 12, 13, and 18, Kuriyama et al disclose all of the limitations as applied to claims 1-3, plus a surface-mounting external terminal (40).

With regard to claims 4-6, 15, and 16, Kuriyama et al disclose the two portions (2a, 2b) of the insulative case, plurality of terminals (4, 5) and a groove (8, 9) which is substantially V-shaped.

With regard to claims 7-10, and 17, Kuriyama et al disclose the first notch and the second notch receiving lead portions respectively of the movable (5) and fixed (4) terminals.

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With regard to claims 19 and 20, Kuriyama et al disclose a communication device (col. 1, lines 15-17) comprising a coaxial connector (Fig. 7a; col. 1, line 6).

Response to Arguments

Applicant's arguments filed 08/22/2002 have been fully considered but they are not persuasive.

Applicants argue that the prior art has a notch extending partially not entirely through the insulative case in a thickness direction and an extension of the notch at the full thickness would not be obvious.

As it was shown in section 1 of this Action, the extension of the notch at the full thickness of the insulative case is not patentably significant since they relate to the size of the article under consideration which is not ordinarily a matter of invention.

It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

However, even the existent depth of the notch seems to prevent the capillary effect, since this effect can be developed if the capillary size distance between terminal and the housing is formed continuously starting from the bottom of the housing. The existent depth of the notch seems to prevent forming the capillary effect. In Kuriyama, the elimination of the part of notch, which serves as a protection against capillary effect, is an obvious expedient since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

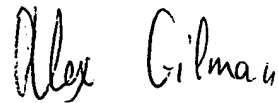
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Gilman whose telephone number is (703) 305-847. The examiner can normally be reached on Monday-Friday, 10:00 a.m - 7:30 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7322 for regular communications and (703) 308-7322 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.

Alexander Gilman

A handwritten signature in black ink that reads "Alex Gilman". The signature is written in a cursive, slightly stylized font.

November 26, 2002